

REMARKS

This Amendment is filed in response to the Non-Final Rejection mailed on June 14, 2006 (the "Rejection"). Claims 1-10, 28-37, and 55-58 are currently pending. Claims 12-27 and 38-54 were previously cancelled in Applicants' After Final Amendment filed on May 31, 2006 (which was entered by the Examiner).

I. CLAIM AMENDMENTS

Applicants have made minor amendments to the claims to correct minor informalities not affecting the scope of the claims. The amendments are not narrowing amendments, nor are they made for reasons of patentability, as considered under the *Festo* decision of the Federal Circuit.

Claims 1 and 28 (both independent) are amended so that the first introduction of a claim element in the body of the claim is made using the article "a" or "an" instead of "said." Claims 10 and 34 has been amended to correct typographical errors.

No new matter has been added. Reconsideration of the outstanding rejections in the present application is respectfully requested based on the following remarks.

II. OBVIOUSNESS REJECTION UNDER 35 U.S.C. § 103

Claims 1-10, 28-37, and 55-58 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over the U.S. Patent No. 6,754,833 to Black et al. ("Black") in view of Network Computing's "The New Face of Single Sign-On" to Philip Carden ("Carden"). The rejections for these claims are hereby respectfully traversed.

As stated in MPEP § 2143, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings as urged by the Examiner in his obviousness rejection. Second, there must be a reasonable expectation of success. Finally, the proffered combination of prior art references (or

references when modified) must have all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

As stated in MPEP § 2143.01, the first requirement of the *prima facie* case provides that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Further, as stated in MPEP § 2143.03, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). That is, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970); *In re Edward S. Lowry*, 32 F.3d 1579, 1582 (Fed. Cir. 1994) ("The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. . . . The PTO may not disregard claim limitations . . .") [underscore added] [citing *In re Gulack*, 703 F.2d 1381 (Fed. Cir. 1983)].

A. Black and Carden fail to teach or suggest all of the claimed limitations

Applicants respectfully submit that the proposed combination of Black and Carden fails to teach or suggest all of the claim limitations, and therefore no *prima facie* case of obviousness exists in this case. Specifically, with respect to claims 1 and 28, the combined references fail to teach or reasonably suggest the following:

- “a single login session,”
- “said host system comprising a financial service provider system with which a user of the host system has one or more financial accounts,”
- “identifying said user’s financial account data,”
- “providing discriminated partner system resources to said user...selected based at least upon...said user’s financial account data,” and
- “wherein providing discriminated partner system resources comprises creating discriminated partner system resources identified with said host system comprising: identifying graphical information used by said host system, replicating said graphical information, classifying said host system, identifying non-conflicting additional partner system resources that do not conflict with said host system’s classification, and incorporating said replicated graphical information and said non-conflicting additional partner system resources into a standard partner system resource to create a discriminated partner system resource.”

Black discloses a system for providing Internet content to users of wireless Internet devices. *See* Black at col. 3, lines 15-19. These wireless devices have relatively limited computing power, reduced-size user interfaces having smaller displays, and fewer input options than traditional Internet devices. *See, e.g.,* Black at col. 7, line 52 - col. 8, line 22. Access to the Internet is provided to these devices by a Wireless Carrier with which the user must establish an operating account. Black at col. 9, lines 28-31. Furthermore, Black speculates that the Wireless Carrier could partner with a so-called “Internet Partner,” which “produces and operates a portal or web-site for the Subscribers of the Wireless Carrier.” Black at col. 9, lines 39-40. In essence, Black sees the Internet Partner as providing expertise in producing Internet content, and the Wireless Carrier as providing expertise in establishing the wireless transmission of this information. In each case, the Internet content itself may be branded to appear to

originate from the Wireless Carrier, the Internet Partner, or both parties. Black at col. 9, lines 41-47.

Black also suggests that a single Internet Partner can provide Internet content for various different Wireless Carriers. Black at col. 9, lines 48-60. To facilitate this, Black discusses that “templates may be used to provide a plurality of differently branded portals or web-sites for different Carriers.” Black at col. 12, lines 33-35. The Examiner appears to equate Black’s Wireless Carrier with the host system of the present invention, and the Internet Partner with the partner system of the present invention.

Carden describes, in only very general terms, the use of Single Sign-On technology in which a user enters a single authentication request to access information on any of several systems.

In contrast, independent claims 1 and 28 recite a method and system that identify a user and provide discriminated partner system resources to a user. The host system — that is, the system to which the user makes initial contact — is “a financial service provider system with which the user has one or more financial accounts.” *See* Specification at p. 11, lines 5-6. When the user seeks to access partner system resources, the claims recite that the user’s financial account data is identified, and then the discriminated partner system resources are selected according to a preexisting association between the host system and the partner system, a preexisting association between the user and the partner system, and the user’s financial account information.

Applicants respectfully submit that independent claim 1 and 28 are distinguished over Black and Carden because they recite features and functionalities directed towards providing a value-added banking experience on the Internet that examines the *user’s financial information* to present various discriminated resources to the user. By using the user’s financial account data in particular, the system can determine which host services the user is already receiving from the host system, and supplement these services with complementary services offered by the partner systems,

while simultaneously discriminating out any partner system services that would conflict or compete with the services that the customer already receives from the host system. This is advantageous because it allows the host financial institution to provide a full range of service, or at least appear to do so, while simultaneously preventing the offer of services that would compete with the host's existing business with the customer.

Black and Carden, on the other hand, disclose a system in which the host is a Wireless Carrier that provides the wireless connection between the user's wireless device and the internet, and the partner is a web developer that produces a custom-tailored web page for the Wireless Carrier to essentially call its own. Neither reference discloses a host system (or even a partner system) being "a financial service provider system with which a user of the host system has one or more financial accounts," as expressly recited in claims 1 and 28. Furthermore, neither reference discloses "identifying said user's financial account data," "providing discriminated partner system resources to said user...selected based at least upon...said user's financial account data," and "wherein providing discriminated partner system resources comprises creating discriminated partner system resources identified with said host system comprising: identifying graphical information used by said host system, replicating said graphical information, classifying said host system, identifying non-conflicting additional partner system resources that do not conflict with said host system's classification, and incorporating said replicated graphical information and said non-conflicting additional partner system resources into a standard partner system resource to create a discriminated partner system resource", as required by the claims.

Because the Internet Provider (the alleged "partner system") of Black is simply providing a tailored web page for the Wireless Carrier (the alleged "host system"), there appears to be little or no reason to discriminate the partner resources relative to the services offered by the host resources, as these services are not in competition, and are intended to be mutually beneficial. Furthermore, the cited art simply describes a

business model in which the Internet Partner sets up a branded web site for a Wireless Carrier. The steps described above are completely missing from Black and Carden, and the Office Action provides no citation in either Black or Carden to support their alleged presence in the prior art. *See* Office Action at ¶ 14.¹ As such, this allegation, without being mentioned in the cited art, cannot support a *prima facie* case of obviousness.

Additionally, the Examiner acknowledges that Black fails to disclose the feature and functionality of “a single login session”, as set forth in claims 1 and 28. The Examiner relies on Carden to make up for this deficiency in Black, but Carden does not disclose this feature and functionality as well. Carden, as acknowledged by the Examiner, merely teaches the “idea.” *See* Office Action at p. 4. For example, Carden describes, in only very general terms, the use of Single Sign-On technology to access information on any of several systems, but fails to make up for the deficiencies of Black to teach or suggest “a single login session” for “providing discriminated partner system resources to a user of host system”, as required by the claimed invention. Therefore, in view of the foregoing, Applicants respectfully request that the obviousness rejection of claims 1 and 28 be withdrawn.

B. Lack of motivation to combine

Even assuming, for the sake of argument, that Black and Carden teach all of the limitations set forth above, Applicants submit that the Examiner does not present a proper motivation to combine the references to achieve the claimed system and method, and thus has failed to set forth a *prima facie* case of obviousness. In particular, Applicants respectfully submit that the allegation that one of ordinary skill in the art would have modified Black by the teaching of Carden to make “the system easier to use

¹ Although the Examiner cites to Black at column 9, line 38 to column 10, line 6 to support this portion of the rejection, this citation merely describes the general concept of providing branded content to users and says nothing about incorporating the features listed above.

and may reduce the number of passwords a user must remember” is not proper motivation to support the combination of reference teachings the Examiner urges. *See* Office Action at p. 4.

First, Applicants respectfully submit that the Examiner improperly *assumes* the combination recited in the claim would be desired. For example, the Examiner asserts that the combination would be “may reduce the number of passwords” (emphasis added). *See* Office Action at p. 4. The PTO has the burden to establish that the prior art taken as a whole suggests the desire or advantage. Here, the Examiner himself simply assumes (not the reference as whole) that it would have been obvious to one of ordinary skill in the art to incorporate a single login session to Black’s method and system of specifically generating and distributing Telecom and Internet revenue. However, the Examiner fails to explain *why* the art as a whole would suggest such a feature specifically for distributing revenue. Furthermore, the assertion that a secondary reference “may” reduce the number of passwords does not constitute specific motivation or suggestion for the combination. The inquiry is not whether, in *post hoc* fashion one reference may benefit from another – rather, the inquiry is whether the prior art provides specific motivation to select the second reference and combine it with the first in the specific manner urged by the Examiner. Thus, Applicant submits that the Examiner’s assumption is clearly improper.

Second, Applicant submits that the Examiner’s assertion of motivation is lacking in *evidence*. Instead, the Examiner improperly relies on his own hindsight conjecture that the feature of a single login session “makes the system *easier to use*” (emphasis added). *See* Office Action at p. 4. For example, the Examiner’s statement that Black would be made “easier to use” from Carden is wholly unsupported. The motivation cited by the Examiner to combine the references is nowhere to be found in either the Black or Carden references. Second, even assuming that the motivation is applicable, Black makes no suggestion that it would benefit from the teachings of Carden, specifically the use of a single login session. For example, Black is concerned with a

business model and method for generating and distributing the Telecom and Internet revenue produced when a subscriber of a wireless carrier accesses a group of specialized services and applications through a web-site, whereas Carden is primarily concerned with minimizing expenditures associated with “password-related helpdesk calls” as an effort to boost security. *See* Carden at p. 6. Therefore, the person of ordinary skill would not likely be motivated to combine teachings from these disparate references to arrive at Applicants’ invention. As a result, Applicants respectfully submit that the combination of Black and Carden would not have been suggested to one of ordinary skill in the art at the time of the invention and that the Examiner’s conclusion is clearly based on improper hindsight reasoning. Thus, the Examiner has failed to set forth a *prima facie* case of obviousness. For at least the reasons discussed above, the obviousness rejection is improper and should be withdrawn.

C. Dependent claims

Claims 2-10, 29-37, and 55-58 are dependent upon either independent claim 1 or 28. Thus, since independent claims 1 and 28 should be allowable for the reasons discussed above, claims 2-10, 29-37, and 55-58 should also be allowable at least by virtue of their dependency on independent claims 1 and 28. Moreover, these claims recite additional features which are not claimed, disclosed, or even suggested by the cited references taken either alone or in combination. For example, claim 56 and 58 recites wherein said additional partner system resources comprise *incentive reward information*. Applicant respectfully submits that none of the cited references, alone or in combination, teach or suggest the device of claim 1 wherein said additional partner system resources comprise incentive reward information.

In view of the foregoing, it is respectfully requested that the aforementioned obviousness rejection of claims 1-10, 28-37, and 55-58 be withdrawn.

III. CONCLUSION

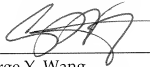
It is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

To the extent necessary, a petition for the extension of time under 37 C.F.R. § 1.136 is hereby made.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0206, and please credit any excess fees to the same deposit account.

Respectfully submitted,

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Dated: August 28, 2006

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